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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,249	02/01/2001	Shin-Ichi Itoh	WN-2298	4330

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,249

Applicant(s)

ITOH, SHIN-ICHI

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is in response to the Request for Reconsideration filed on 06/14/2004. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-9, 11-14, 16-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. (US 5,862,202), hereinafter referred as Bashoura, in view of Stevens (TCP/IP Illustrated, Volume 1 – The Protocols).**

4. As per claim 1, Bashoura teaches:

a control portion which controls a network by the use of an internet protocol (*i.e., fax sender sends file to an IP address*) (Bashoura, C4: L13-19 and 58-65);

a readout portion which reads-out a paper to produce an image data signal (*inherently that fax machines scan a paper to send as an image data signal*);

an operation portion which inputs an Internet protocol address as a transmitting destination of the image data signal (*i.e., computer provides an IP address for sending the file*) (Bashoura, C4: L13-19 and L58-65); and

a transmission portion which directly transmits the image data signal to the terminal having the inputted address (*i.e., received at the remote computer designated by the destination IP address*) (Bashoura, C5: L17-25).

However, Bashoura does not explicitly teach using a transmission control protocol to control the network. Stevens teaches that TCP can be used with IP to provide services to the application layer (Stevens, Section 17.1 Introduction, page 223).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Bashoura invention to include controlling the network by using TCP, as taught by Stevens, because TCP provides a connection-oriented, reliable, byte stream service, as taught by Stevens (Stevens, Section 17.2 TCP Services, page 223).

5. As per claim 3, Bashoura-Stevens teaches the apparatus of claim 1, wherein the transmission portion transmits the image data signal to the terminal by using a simple mail transfer (Stevens, Section 28.1 Introduction, pages 441-442).

6. As per claim 4, Bashoura-Stevens teaches the apparatus of claim 1, wherein the transmission portion transmits the image data signal to the terminal by using a file transfer protocol (Bashoura, C4: L13-19 and L58-65).

7. As per claim 5, Bashoura-Stevens teaches the apparatus of claim 1, wherein the terminal comprising any one of a personal computer and a workstation (*i.e., remote computer 19 in Fig. 1*) (Bashoura, C5: L17-25).

8. As per claim 6, Bashoura-Stevens teaches the apparatus of claim 1, wherein a plurality to terminals connected to an Ethernet (*local fax machine 1, fax director 3, local computer 5 and fax sender 9 connected to each other as illustrated in Fig. 1*) (Bashoura, C2: L35-44).

9. As per claim 7, Bashoura-Stevens teaches the apparatus of claim 6, wherein the terminals comprising a first terminal and a second terminal (*local fax machine 1, fax director 3, local computer 5 and fax sender 9 connected to each other as illustrated in Fig. 1*).

However, the modified Bashoura invention does not explicitly teach the first terminal being connected to the second terminal via a router. "Official Notice" is taken that both the concept and advantages of connecting terminals via a router are both well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Bashoura-Stevens invention to include connecting terminals via a router because routers are common network devices used for interconnecting two networks, both commonly using IP addresses.

10. As per claim 8, Bashoura-Stevens teaches the apparatus of claim 1, wherein the image data signal being directly transmitted to the terminal without using a server (Bashoura, Fig. 1).

11. Claims 9, 11-13 are corresponding method claims of apparatus claims 1, 3-4 and 8; therefore, they are rejected under the same rationale.

12. Claims 14 and 16-17 are corresponding computer-readable storage medium claims of apparatus claims 1 and 3-4; therefore, they are rejected under the same rationale.

13. Claims 18 and 20-21 are corresponding program claims of apparatus claims 1 and 3-4; therefore, they are rejected under the same rationale.

14. Claims 2, 10, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura, in view of Stevens, and further in view of Kadowaki (US 6,674,537).

15. As per claim 2, Bashoura-Stevens teaches the apparatus of claim 1, but does not explicitly teach anything about one-touch memory buttons.

In a related art, Kadowaki teaches a one-touch button memory portion which stores an Internet protocol address in advance (*i.e., one-touch dialing can store destination network addresses*) (Kadowaki, C16: L51-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bashoura-Stevens and Kadowaki to include a one-touch button for storing IP addresses in advance since such methods were conventionally employed in the art for the obvious reason of reducing the number of keystrokes required by a user when entering the destination for a facsimile to be sent.

16. Claims 10, 15, and 19 claim similar limitations to claim 2 and are rejected on the same grounds as claim 2.

Response to Arguments

17. In the remarks, Applicant argued in substance that

(A) Applicant argued "the Examiner's comments constitute impermissible hindsight and an improper assertion of technical fact in an area of esoteric technology with support by citation of any reference work".

As to point (A), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, **Bashoura** does not explicitly teach using a Transmission Control Protocol (TCP) to control the network. In a related art, **Stevens** teaches that TCP can be used with Internet Protocol (IP) to provide services to the application layer (**Stevens**, Section 17.1 Introduction, and page 223).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the **Bashoura** invention to include controlling the network by using TCP, as taught by **Stevens**, because TCP provides a connection-oriented, reliable, byte stream service, as taught by Stevens, to be used in communications network environment (**Stevens**, Section 17.2 TCP Services, page 223).

18. Applicant's arguments as well as request for reconsideration filed on 06/14/2004 have been fully considered but they are not deemed to be persuasive.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RUPAL DHARIA
SUPERVISOR/EXAMINER